

REMARKS

INTRODUCTION:

In accordance with the following, no claims have been added, amended or cancelled herein. Claims 1-18 are pending while claims 1-14 are under consideration. Claims 1 and 10 are independent claims.

Reconsideration of the claims, in light of the following discussion is respectfully requested.

ALLOWABLE SUBJECT MATTER:

Claims 4-9 are objected to but are indicated as allowable if rewritten in independent form. Applicant will hold the rewriting of these claims in abeyance until the arguments presented herein have been considered.

REJECTIONS UNDER 35 USC § 103:

Claims 1-3 and 10-14 stand rejected under 35 102(e) as being unpatentable in view of an Abstract of Korean Publication No. P1991-0008507 by Lee ("Lee Abstract"). Applicant respectfully traverses the rejections for at least the following reasons.

Independent claim 1 recites at least the following:

converting the number of tracks into a step counter value to obtain a step counter value of the home position;

Lee Abstract fails to suggest or disclose at least the above-recited features of independent claim 1.

The Office Action asserts at page 2 that Lee Abstract describes all of the above-recited features. However, the Office Action fails to specifically set forth how the above-claimed features are described in Lee Abstract. For example, Lee Abstract fails to even mention a "step counter" or a "home position." If the rejection is to be maintained, Applicant respectfully request the Office provide a specific paragraph number and figure reference from a translated version of Lee (see below). Further, any subsequent Office Action should be made non-final to give Applicant an opportunity to review the Office's position as to these arguments and to clarify the record for appeal.

Independent claim 1 recites at least the following:

wherein the step counter value of the home position is an integer varying depending on the position of the optical pickup when power is applied.

Lee Abstract fails to suggest or disclose at least the above-recited features of independent claim 1.

The Office Action asserts at page 2 that Lee Abstract describes all of the above-recited features. However, the Office Action fails to specifically set forth how the above-claimed features are described in Lee Abstract. For example, Lee Abstract fails to even mention a "step counter" or a "an integer." If the rejection is to be maintained, Applicant respectfully request the Office provide a specific paragraph number and figure reference from a translated version of Lee (see below). Further, any subsequent Office Action should be made non-final to give Applicant an opportunity to review the Office's position as to these arguments and to clarify the record for appeal.

Independent claim 1 recites at least the following:

A method of eliminating home-in noise of an optical disc drive without a home limit switch and using a variable step counter, comprising:

Lee Abstract fails to suggest or disclose at least the above-recited features of independent claim 1.

The Office Action asserts at page 2 that Lee Abstract describes all of the above-recited features. However, the Office Action fails to specifically set forth how the above-claimed features are described in Lee Abstract. For example, Lee Abstract fails to even mention an "optical disc drive without a home limit switch" or a "variable step counter."

A preamble is entitled to patentable weight when it is "necessary to give life, meaning, and vitality" to the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). So, when an Applicant uses the body of a claim and the preamble to define the claimed subject matter as in the above-recited claim language, the preamble should be accorded patentable weight.

Accordingly, Applicant asserts the Office must provide evidence as to how Lee teaches all of the above-recited features. If the rejection is to be maintained, Applicant respectfully request the Office provide a specific paragraph number and figure reference from a translated version of Lee (see below). Further, any subsequent Office Action should be made non-final to

give Applicant an opportunity to review the Office's position as to these arguments and to clarify the record for appeal.

Accordingly, Applicant respectfully submits that independent claim 1 patentably distinguishes over Lee Abstract, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claim 10, with potentially differing scope and breadth, are not suggested or disclosed by Lee Abstract, the rejection should be withdrawn and claim 10 also allowed.

Further, Applicants respectfully submit that claims 2-3 and 11-14, which depend from independent claims 1 and 10, should be allowable for at least the same reasons as claims 1 and 10, as well as for the additional features recited therein.

REJECTION BASED ON ABSTRACT IS IMPROPER / TRANSLATION REQUESTED:

Applicants assert the rejection of claims 1-3 and 10-14 based on the Lee Abstract is improper. MPEP § 706.02, part II states:

Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished).

Further, "if a document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection" (MPEP 706.02, section II (emphasis added)).

Accordingly, Applicant respectfully requests a translation of the Lee Abstract in any future office action relying on the same in order to demonstrate that Lee Abstract fails to anticipate or render obvious the claims of the present application. Further, Applicant requests that support for the rejection be provided from the specification of Lee itself, rather than from the abstract, if the rejection is to be maintained.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

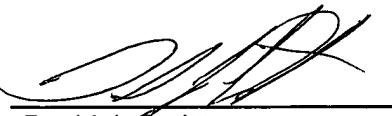
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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